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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,249	02/01/2001	Shin-Ichi Itoh	WN-2298	4330

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EXAMINER

NGUYEN, QUANG N

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/773,249

Applicant(s)

ITOH, SHIN-ICHI

Examiner

Quang N. Nguyen

Art Unit

2141

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER

Detailed Action

1. This Office Action is in response to the Request for Reconsideration filed on 07/06/2005. Claims 1-21 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 3-9, 11-14, 16-18, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. (US 5,862,202), hereinafter referred as Bashoura, in view of Stevens (TCP/IP Illustrated, Volume 1 – The Protocols).**

4. As per claim 1, Bashoura teaches:

a control portion which controls a network by the use of an internet protocol (IP) (*i.e., fax sender 9 sends file to an IP address*) (Bashoura, C4: L13-19 and 58-65);

a readout portion which reads-out a paper to produce an image data signal (*inherently, fax machines scan a paper/document, then send as an image data signal*);

an operation portion which inputs an Internet protocol address as a transmitting destination of the image data signal (*i.e., computer 5 provides an IP address as a transmitting destination for sending the file*) (Bashoura, C4: L13-19 and L58-65); and

a transmission portion which directly transmits the image data signal to the terminal having the inputted address (*i.e., fax sender 9 transmits the image data signal from the local fax machine 1 to the remote computer 19 designated by the destination IP address*) (Bashoura, Fig. 1 and C4:L58 - C5: L25).

However, Bashoura does not explicitly teach using a transmission control protocol (TCP) to control the network.

In a related art, Stevens teaches that TCP provides a reliable, connection-oriented, byte stream, transport layer service and TCP can be used with IP (*i.e., using the network layer IP*) to provide services to the application layer (*such as to transmit data over the Internet*) (Stevens, Chapter 17, TCP: Transmission Control Protocol, pages 223-228).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Bashoura invention to include controlling the network by using TCP with IP, as taught by Stevens, because TCP provides a connection-oriented, reliable, byte stream service, as taught by Stevens, to be used in communications network environment (Stevens, Section 17.2 TCP Services, page 223).

5. As per claim 3, Bashoura-Stevens teaches the apparatus of claim 1, wherein the transmission portion transmits the image data signal to the terminal by using a simple mail transfer protocol (Stevens, Chapter 28, SMTP: Simple Mail Transfer Protocol, pages 441-459).

6. As per claim 4, Bashoura-Stevens teaches the apparatus of claim 1, wherein the transmission portion transmits the image data signal to the terminal by using a file transfer protocol (FTP) (Bashoura, C4: L13-19 and L58-65).

7. As per claim 5, Bashoura-Stevens teaches the apparatus of claim 1, wherein the terminal comprising any one of a personal computer and a workstation (*i.e., remote computer 19 in Fig. 1*) (Bashoura, C5: L17-25).

8. As per claim 6, Bashoura-Stevens teaches the apparatus of claim 1, wherein a plurality to terminals connected to an Ethernet (*local fax machine 1, fax director 3, local computer 5 and fax sender 9 connected to each other as illustrated in Fig. 1*) (Bashoura, C2: L35-44).

9. As per claim 7, Bashoura-Stevens teaches the apparatus of claim 6, wherein the terminals comprising a first terminal and a second terminal (*local fax machine 1, fax director 3, local computer 5 and fax sender 9 connected to each other as illustrated in Fig. 1*).

However, the modified Bashoura invention does not explicitly teach the first terminal being connected to the second terminal via a router. "Official Notice" is taken that both the concept and advantages of connecting terminals via a router are both well known and expected in the art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Bashoura-Stevens invention to include connecting terminals via a router because routers are common network devices used for interconnecting two networks, both commonly using IP addresses.

10. As per claim 8, Bashoura-Stevens teaches the apparatus of claim 1, wherein the image data signal being directly transmitted to the terminal without using a server (Bashoura, Fig. 1).

11. Claims 9, 11-13 are corresponding method claims of apparatus claims 1, 3-4 and 8; therefore, they are rejected under the same rationale.

12. Claims 14 and 16-17 are corresponding computer-readable storage medium claims of apparatus claims 1 and 3-4; therefore, they are rejected under the same rationale.

13. Claims 18 and 20-21 are corresponding program claims of apparatus claims 1 and 3-4; therefore, they are rejected under the same rationale.

14. Claims 2, 10, 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura, in view of Stevens, and further in view of Kadowaki (US 6,674,537).

15. As per claim 2, Bashoura-Stevens teaches the apparatus of claim 1, but does not explicitly teach anything about one-touch memory button operation.

In a related art, Kadowaki teaches a one-touch button memory portion which stores an Internet protocol address in advance (*i.e., one-touch dialing can store destination network addresses*) (Kadowaki, C16: L51-57).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Bashoura-Stevens and Kadowaki to include a one-touch button for storing IP addresses in advance since such methods were conventionally employed in the art for the obvious reason of reducing the number of keystrokes required by a user when entering the destination for a facsimile to be sent, *i.e., quick dialing, to avoid errors in inputting the telephone number (i.e., inputting the destination address).*

16. Claims 10, 15, and 19 claim similar limitations to claim 2 and are rejected on the same grounds as claim 2.

Response to Arguments

17. In the remarks, Applicant argued in substance that

(A) Applicant argued “the combination proposed by the Examiner does not provide a network scanner apparatus which is capable of directly transmitting an image data signal from a scanner device to a PC without using a mail server”, as claimed in the invention.

As to point (A), before addressing the argument, Examiner submits that a “**scanner**” apparatus could be given a broad and reasonable interpretation as “an optical input device that uses light-sensing equipment to capture an image on paper or some other subject and the image is translated into a digital signal that can then be manipulated by optical character recognition (OCR) software or graphic software” (according to the Microsoft Computer Dictionary – Fifth Edition, pages 464-465 attached here as references). In this case, Bashoura teaches a fax routing system and method using a local fax machine 1 of Fig. 1 (*as defined in Microsoft Computer Dictionary – Fifth Edition, page 207, a fax machine is a device that scans pages, converts images of those pages to a digital format consistent with the international facsimile standard, and transmits the image through a telephone line*), which is capable of directly transmitting an image data signal to a remote computer 19 without using a mail server as illustrated in Fig. 1. Hence, Prior Arts do provide “a network scanner apparatus which is capable of directly transmitting an image data signal to a PC without using a mail server.

(B) Applicant argued "the Examiner's comments constitute impermissible hindsight and an improper assertion of technical fact in an area of esoteric technology with support by citation of any reference work".

As to point (B), in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, **Bashoura** teaches the use of Internet Protocol (IP) in transmitting the image data signal to the terminal having an IP address but does not explicitly teach using a Transmission Control Protocol (TCP) to control the network.

In a related art, **Stevens** teaches that TCP can be used with Internet Protocol (IP) to provide services to the application layer (such as to transmit data over the Internet) (**Stevens, Section 17.1 Introduction, and page 223**).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the **Bashoura** invention to include controlling the network by using TCP, as taught by **Stevens**, because TCP provides a connection-oriented, reliable, byte stream service, as taught by Stevens, to be used in communications network environment (**Stevens, Section 17.2 TCP Services, page 223**).

18. Applicant's arguments as well as request for reconsideration filed on 07/06/2005 have been fully considered but they are not deemed to be persuasive.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (571) 272-3886.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (571) 272-3880. The fax phone number for the organization is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).